

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte LARRY RICHARD ROBINSON,
and ROBERT BAO KIM HA

Appeal No. 2006-0266
Application No. 09/867,235

ON BRIEF

MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before SCHEINER, ADAMS, and GREEN, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 27-31, which are all the claims pending in the application.

Claim 27 is illustrative of the subject matter on appeal and is reproduced below:

27. A method of enhancing the delivery of oil-soluble skin care actives into the skin comprising applying to the skin of a mammal in need of treatment, a safe and effective amount of a water-in-oil composition consisting essentially of:
 - a) an oil soluble skin care active, selected from the group consisting of terpene alcohols, oil-soluble phytosterols, oil-soluble anti-acne actives, oil-soluble beta-hydroxy acids, oil-soluble vitamin B₃ compounds, oil-soluble retinoids, oil-soluble anti-oxidants, oil-soluble radical scavengers, oil-soluble chelators, oil-soluble flavonoids, oil-soluble anti-inflammatory

agents, oil-soluble anti-cellulite agents, oil-soluble topical anesthetics, and mixtures thereof, wherein said skin care active is delivered into the skin in order to impart positive skin care benefits;

- b) a silicone oil; and
- c) a silicone elastomer.

The references relied upon by the examiner are:

Rouquet et al. (Rouquet) EP 0,908,175 A1 Apr. 14, 1999

Mosby's Medical Dictionary (Mosby), "erthyema," 4th Edition, Mosby-Year Book, Inc., (1994)

Stedman's Medical Dictionary (Stedman), "sunscreen," 27th Edition, Thomson PDR, (2002-2004)

GROUND OF REJECTION

Claims 27-31 stand rejected under 35 U.S.C. § 102(b) as anticipated by Rouquet.

CLAIM GROUPING

Appellants do not separately group or argue their claims. Accordingly, claims 27-31 stand or fall together. Since all claims stand or fall together, we limit our discussion to representative independent claim 27. Claims 28-31 will stand or fall together with claim 27. In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

DISCUSSION

According to the examiner (Answer, page 3), Rouquet teaches "stable topical compositions containing solid elastomeric organopolysiloxane...." Specifically, the examiner finds (id.), Rouquet exemplify (page 10), a water-in-oil

composition comprising “dimethicone copolyol (silicone oil), cyclomethicone (silicone oil)^[1], octyl methoxycinnamate (oil-soluble sunscreen anti-inflammatory agent^[2]), and KSG-16^[3] (crosslinked silicone elastomer [sic]), wherein foundations are applied to the skin.” Accordingly, the examiner finds (Answer, bridging sentence, pages 3-4), Rouquet “and the instant invention both teach a method of applying to the skin^[4] a composition comprising a water-in-oil emulsion comprising a silicone oil, a crosslinked silicone elastomer, and a skin care active, all of which are in the oil-phase.”

The examiner relies on Stedman and Mosby as extrinsic evidence to explain the meaning of the term “sunscreen” as used in Rouquet. In re Baxter Travenol Labs., 952 F.2d 388, 21 USPQ2d 1281 (Fed. Cir. 1991). According to Stedman (emphasis removed), a “sunscreen” is “a topical product that protects the skin from ultraviolet-induced erythema and resists washing off; its use also reduces formation of solar keratoses and reduces ultraviolet-B-induced melanoma and nonmelanoma skin cancers and wrinkling.” Mosby defines “erythema” as “redness or inflammation of the skin or mucous membranes....” Thus, it appears that the use of the sunscreen, octyl methoxycinnamate, in the water-in-oil makeup foundation of Rauquet is to protect the skin from ultraviolet-

¹ According to appellants' specification (page 16), “[n]on-limiting examples of common silicone oils that may be used in the present invention include cyclomethicone, dimethicone, and mixtures thereof.” In this regard, we note that the composition of appellants' examples 2 and 4-6 contains both cyclomethicone and dimethicone copolyol. Appellants' specification, pages 34-35.

² See e.g., Rauquet, page 8, paragraph [0033].

³ According to appellants' specification (page 15), preferred non-emulsifying elastomers include dimethicone/vinyl dimethicone crosspolymers including “KSG-15, 16 [and] 18....”

⁴ According to Rauquet (page 7), “the composition of the invention forms a base for skincare or makeup, to be applied on the skin or lips before the skincare or makeup product.”

induced redness or inflammation. According to appellants' specification (page 5),

The compositions of the present invention are also useful for regulating the condition of skin and especially for regulating keratinous tissue condition. Regulation of skin condition, namely mammalian and in particular human skin condition, is often required due to conditions which may be induced or caused by factors internal and/or external to the body. Examples include, ... radiation exposure (including ultraviolet radiation).... "[R]egulating skin condition" includes prophylactically regulating...."

Based on the foregoing analysis, we agree with the examiner that Rouquet teach a method wherein a composition comprising an oil soluble skin care active (octyl methoxycinnamate) together with a silicone oil (dimethicone copolyol, and cyclomethicone), and a silicone elastomer (KSG-16) is applied to the skin of a mammal. While, Rouquet is silent on the ability of the method to enhance the delivery of oil-soluble skin care actives into the skin, absent evidence to the contrary we find this property to be inherent in the application of Rouquet's composition to the skin.

In response, appellants argue (Brief, pages 3-5) that Rouquet teaches a number of skin care actives of which only a few are set forth in appellants' claimed invention. In addition, appellants assert (Brief, page 4), Rouquet "makes no distinction between water-soluble and oil-soluble actives." According to appellants (Brief, page 4), "a broad disclosure in the prior art ... does not necessarily preclude patenting of sub-classes or individual compounds." While, we agree with appellants, see e.g., In re Baird, 16 F.3d 380, 383, 29 USPQ2d 1550, 1553 (Fed. Cir. 1994), the rejection before us on this appeal is specifically limited to a method which comprises the application of the composition set forth

in Example 2 (page 10 of Rouquet) to the skin of a mammal. As the examiner points out (Answer, page 5), Rouquet "teaches a specific anti-inflammatory agent, octyl methoxycinnamate ... [a] specie of the active recited [in appellants' claim]. We agree. Accordingly, we are not persuaded by appellants' argument.

Appreciating that Rouquet's Example 2 teaches a sunscreen, appellants assert (Brief, page 4), Rouquet "explicitly teaches actives, for example sunscreens, that are effective only on the surface of the skin." Initially, we note that appellants' do not dispute the examiner's characterization of a sunscreen as an anti-inflammatory agent. Accordingly, we find that appellants' concede this point. Further, while appellants assert (*id.*), that sunscreens are only effective on the skin's surface, appellants provide no evidence to support this assertion. In this regard, we remind appellants that attorney argument cannot take the place of evidence lacking in the record. Meitzner v. Mindick, 549 F.2d 775, 782, 193 USPQ 17, 22 (CCPA 1977). As the examiner points out (Answer, page 5), "[t]he only active step recited [in appellants' claim 27] is to apply [] the ... composition onto the skin. Therefore, the applying of Rouquet's composition to the skin would inherently practice the recited step of 'delivering the active into the skin,[]' absent evidence to the contrary." We agree. The claimed method comprises a single step - applying the recited composition to the skin. As discussed above, Rouquet teaches the application of a composition within the scope of claim 27, to the skin of a mammal. Therefore, we agree with the examiner's finding that applying Rouquet's composition to the skin would inherently result in delivering the active agent (octyl methoxycinnamate) into the skin. In re King, 801 F.2d

1324, 231 USPQ 136 (Fed. Cir. 1986). Accordingly, we find no error in the examiner's prima facie case of anticipation based on inherency. After the PTO establishes a prima facie case of anticipation based on inherency, the burden shifts to appellant to "prove that the subject matter shown to be in the prior art does not possess the characteristic relied on." In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 229 (CCPA 1971). Accord In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980), quoted with approval in In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985); In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); In re Ludtke, 441 F.2d 660, 664, 169 USPQ 563, 566 (1971).

In this regard, we recognize appellants' reference to the Robinson Declaration, received September 20, 2004, to distinguish "the subclass of oil-soluble actives over the more general class of vitamins and anti-oxidants..." set forth in Rouquet. Brief, bridging paragraph, pages 4-5. Accordingly, we have considered the Robinson Declaration for evidence that the composition taught by Rouquet would not inherently deliver octyl methoxycinnamate into the skin. Upon review of the Robinson Declaration, we find that Robinson concludes "this data indicate that delivery of the oil-soluble skin care active [(Farnesol)] is significantly enhanced when delivered from a vehicle containing water, silicone and silicone elastomer relative to the delivery of the same oil soluble skin care active from a vehicle that does not contain a silicone elastomer." The Robinson Declaration does not address the composition set forth in Example 2 of Rouquet, or attempt to explain why the application of the composition set forth in Example

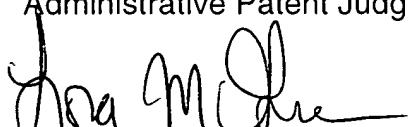
2 of Rouquet, would not result in enhancing the delivery of the oil-soluble skin care active (octyl methoxycinnamate) into the skin. Therefore, we find the Robinson Declaration insufficient to overcome the rejection of record.

For the foregoing reasons, we find no error in the rejection of record. Accordingly, we affirm the rejection of claim 27 under 35 U.S.C. § 102(b) as anticipated by Rouquet. As set forth above, claims 28-31 fall together with claim 27.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED


Toni R. Scheiner)
Administrative Patent Judge)
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Donald E. Adams) BOARD OF PATENT
Administrative Patent Judge)
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Lora M. Green) APPEALS AND
Administrative Patent Judge) INTERFERENCES
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